

REMARKS

The Office Action dated August 23, 2005, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, the Specification and claim 1 have been amended. No new matter has been added. Support for the amendments to the Specification can be found in claim 3 as originally filed. Support for the amendments to claim 1 can be found in Figs. 1-6 of the application as originally filed. Claims 1, 2 and 4-13 are pending and respectfully submitted for consideration.

Rejection Under 35 U.S.C. § 112

Claims 9 and 13 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Applicant has amended the Specification responsive to the rejection.

Rejection Under 35 U.S.C. § 102

Claims 1, 2, 4, 6-9 and 11-13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Brown (U.S. Patent No. 4,782,603). The Applicant traverses the rejection and respectfully submits that claims 1, 2, 4, 6-9 and 11-13 recite subject matter that is neither disclosed nor suggested by Brown. Claims 2, 4, 6-9 and 11-13 depend from claim 1.

Brown discloses a shoe 10 with an upper 20, a midsole 30, and an outsole 40. The midsole is formed with an assembly 50 of six smaller diameter tubes disposed in the front, or forefoot region 55 of the shoe, and an assembly 60 of seven larger diameter tubes disposed in the rear, or heel region 65 of the shoe. Tube assemblies 50, 60 are constructed from nitrile butadiene or other rubber-based compounds and are more dense than the material used for the midsole to withstand repeated impact forces.

With respect to claim 1, the Applicant respectfully submits that Brown fails to disclose or suggest the claimed features of the invention. Claim 1, as amended, recites that the tubular elements extend the entire width of the sports shoe and the outer ends of the tubular elements extend to an outer surface of the pair of laterally disposed walls. In contrast, Brown discloses that in constructing the midsole, it has been found that it is preferable to completely encapsulate the tubes 50, 60 rather than leaving the ends exposed along the sides of the shoe. See column 3, lines 14-17 of Brown. Therefore, in contrast to the structure recited in amended claim 1, and shown in the figures of the invention, Brown discloses tubes that are encapsulated in the sole of the shoe. Therefore, the tubes cannot extend the entire width of the sport shoe, and the outer ends of the tubes cannot extend to an outer surface of the sides of the shoe.

In addition, claim 1, as amended, recites at least one absorber set disposed in a sole of the sport shoe, the at least one absorber set having a plurality of tubular elements arranged parallel to and detached from one another. In contrast, as disclosed in Brown, each assembly 50, 60 in the shoe 10 includes strips 70 that attach the tubes to each other. Therefore, Brown does not disclose or suggest at least one absorber set

having a plurality of tubular elements arranged parallel to and detached from one another, as recited in amended claim 1.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim [t]he identical invention must be shown in as complete detail as is contained in the patent claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (Emphasis added). Accordingly, Brown does not anticipate claims 1, 2, 4, 6-9 and 11-13 nor are claims 1, 2, 4, 6-9 and 11-13 obvious in view of Brown. As such, the Applicant submits that claims 1, 2, 4, 6-9 and 11-13 are allowable over Brown.

Rejection Under 35 U.S.C. § 103(a)

Claims 5 and 10 were rejected under 35 U.S.C. § 103(a) as being obvious over Brown. Claims 5 and 10 depend from claim 1. The Applicant traverses the rejection and respectfully submits that as claims 5 and 10 depend from claim 1, they are allowable at least for the same reasons as claim 1.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art

reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

In view of the above, the Applicant respectfully submits that Brown fails to support a *prima facie* case of obviousness for purposes of a rejection of claims 5 and 10 under 35 U.S.C. §103.

Conclusion

Claims 2 and 4-13 depend from claim 1. The Applicant respectfully submits that each of these claims incorporates the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above with respect to claim 1. Accordingly, the Applicant respectfully requests withdrawal of the rejections, allowance of claims 1, 2 and 4-13, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 024733-00010.**

Respectfully submitted,



Rhonda L. Barton
Attorney for Applicant
Registration No. 47,271

Customer No. 004372
ARENT FOX PLLC
1050 Connecticut Avenue, N.W., Suite 400
Washington, D.C. 20036-5339
Tel: (202) 857-6000
Fax: (202) 638-4810

GEO/RLB/elz/vdb

TECH/381012.1